

## **REMARKS**

Reconsideration of this application is respectfully requested.

Applicant respectfully submits the following remarks in response to the Official Action of August 3, 2004, and in view of the Examiner telephone interview of October 7, 2004.

In the Office Action, the Examiner rejects claims 2-9 and 11-18. Claims 4-9 and 13-18 are rejected under 35 U.S.C. §103(a) as being allegedly unpatentable over U.S. Patent No. 4,965,569 to Bennett et al. (hereinafter "Bennett"), U.S. Patent No. 5,687,216 to Svensson (hereinafter "Svensson") and U.S. Patent No. 4,477,807 to Nakajima et al. (hereinafter "Nakajima"). Claims 2 and 11 are rejected under 35 U.S.C. §103(a) as being allegedly unpatentable over Bennett, Svensson and Nakajima, and further in view of either U.S. Patent No. 5,793,304 to Sone (hereinafter "Sone"), U.S. Patent No. 6,166,621 to Burgan et al. (hereinafter "Burgan") or U.S. Patent No. 4,975,694 to McLaughlin et al. (hereinafter "McLaughlin"). Claims 3 and 12 are rejected under 35 U.S.C. §103(a) as being allegedly unpatentable over Bennett, Svensson and Nakajima, and further in view of U.S. Patent No. 5,430,436 to Fennell (hereinafter "Fennell"). Applicant respectfully traverses the above rejections for at least the reasons as set forth below.

Independent method claim 4 recites a method of displaying messages in a selective call radio apparatus comprising the steps of displaying stored messages on a display unit in a first display attribute, and when a new message is received during the display of the stored messages, temporarily stopping the display of the stored messages on the display unit and displaying the new message on the display unit in a second display attribute different from the first display attribute, and then restoring the stored message being read immediately before receipt of the new message.

Independent apparatus claim 13 recites a selective call radio apparatus comprising a display unit, a storage unit for storing messages, an operation unit used to input instructions and data, a message receiving unit, and a control unit for reading out the stored messages from the storage unit to display on the display unit in a first display attribute, and for displaying a new message on the display unit in a second display attribute different from the first display attribute when the new message is received by the message receiving unit, and the control unit restores the stored message being read immediately before receipt of the new message.

In the Office Action on page 3, the Examiner alleges that Svensson, in Col. 8, Table 1, teaches *interrupting display of a stored message* to indicate a different mode and upon completion of reviewing the new message, *returning to the same location of reviewing the stored messages.*

However, as pointed out during the telephone interview, Svensson, in Table 1 and in the description on Cols. 7-9, only teaches a list of possible user actions when reading through messages in a cellular phone. Particularly, when a user is reading a message on the cellular phone, the user is able to “store” the number from where the message came from. Once the number is stored, the user is returned to the same line in the message he was reading. So when a user receives a text message on a cellular phone, he is simply given the option of storing the number from where the message came, and then returned to the message once the number is stored.

Thus, Svensson never teaches a new message being received and displayed while the user is reading or browsing through stored messages. It simply gives the user the option of storing a number in a cellular phone from where a message came from, and returning to the same point in the message once the number is stored in the cellular phone.

The present invention, on the other hand, clearly allows the user to return to the same part of message that was being read after display of a new message. Thus, if a user is reading through stored messages, and a new message is received, the new message is immediately displayed to the user in a different attribute than the stored message being read, and once the user is done reading the new message, he is returned to the original message being read.

The cited references of Bennett and Nakajima fail to show this feature as outlined above. Further, Bennett, in Col. 17, lines 29-36 and 60-63, only teaches that an interrupt is caused by an incoming paging information, and if the interrupt is caused by an incoming message, then the message is recorded (Fig. 9A). The present invention teaches displaying the new message when received in a second attribute different from a first attribute of the stored message, *not* recording it. Nakajima only teaches a sequential display of stored messages.

It has been held by the Courts that to establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). The cited references of Bennett, Nakajima and Svensson, individually or in combination, fail to teach or suggest all the claim limitations of independent claims 4 and 13. As the dependent claims recite additional unique features and/or elements, these claims also remain patentable over the cited references.

Thus, Applicant respectfully requests withdrawal of the 35 U.S.C. §103(a) rejection of claims 4-9 and 13-18 over Bennett, Svensson and Nakajima, the 35 U.S.C. §103(a) rejection of claims 2 and 11 over Bennett, Svensson and Nakajima, and further in view of either Sone, Burgan or McLaughlin, and the 35 U.S.C. §103(a) rejection of claims 3 and 12 over Bennett, Svensson and Nakajima, and further in view of Fennell. Accordingly, Applicant respectfully requests allowance of claims 2-9 and 11-18.

In view of the above, it is respectfully submitted that this application is in condition for allowance. Accordingly, it is respectfully requested that this application be allowed and a Notice of Allowance issued. If the Examiner believes that a telephone conference with Applicant's attorney would be advantageous to the disposition of this case, the Examiner is requested to telephone the undersigned.

Respectfully submitted,



Aasheesh V. Shravah  
Registration No. 54,445

SCULLY, SCOTT, MURPHY & PRESSER  
400 Garden City Plaza - Ste. 300  
Garden City, New York 11530  
(516) 742-4343

AVS:jam